

III. REMARKS

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Several claims, including claims 44 and 45 have been amended strictly from a formal standpoint and not for the purpose of distinguishing over any prior art.

In response to the examiner's detailed action on page 2 of the above office action, applicant submits the following.

Independent claim 44 contains the limitations of allowable dependent claim 22 and its corresponding claim 18 written in independent form. Thus, since claim 22 was indicated provisionally allowable (subject to be rewritten in independent form), claim 44 should be in condition for allowance.

Independent claim 45 contains the limitations of claim 22 and independent claim 19 written in independent form. Claim 19 is similar in scope to claim 18 but differs in some respects. For example, claim 19 recites:

1. The comparing device checks the authorization of the merchant station for the method, using the merchant checking device, and the authorization of the SIM card for the method, using the subscriber checking device,

2. The comparing device makes a connection through the interface device for mobile cell phone connections corresponding to the identification code for the mobile cell phone contained in the transaction data,

3. The comparing device transmits the transaction data to the mobile cell phone and sends a request for confirmation to this.

By virtue of claim 45 containing the limitations of claim 19 (including the above limitations) and the limitations of claim 22 (which was indicated allowable on the record), claims 45 distinguishes over Hultergren (WO98/47116) in view of Musa (U.S. 6,016,349) which were applied against some claims in the office action mailed Oct. 2, 2001.

More specifically, in addition to several limitations of claim 18, claim 45 includes, inter alia, the following limitations:

- 1, The identification code of each merchant station and the account number associated therewith in the account keeping device are held in the merchant checking device, and in that

2. The control device transmits to the account keeping device the account number corresponding to the identification code, on the basis of the information in the merchant memory device, rather than the identification code of the merchant station.
3. The comparing device checks the authorization of the merchant station for the method, using the merchant checking device, and the authorization of the SIM card for the method, using the subscriber checking device,
4. The comparing device makes a connection through the interface device for mobile cell phone connections corresponding to the identification code for the mobile cell phone contained in the transaction data,
5. The comparing device transmits the transaction data to the mobile cell phone and sends a request for confirmation to this.

Some of the previous claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Hultergren in view of Musa. However, this rejection is not applicable to new [or amended] claim 45 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 45 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hultergren and Musa, alone, or in combination, do not teach the above combination of limitations.

Therefore, it is impossible to render the subject matter of claim 45 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 45, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Hultergren and Musa patents cannot be combined and applied to reject claim 45 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Hultergren and Musa do not teach, or even suggest, the desirability of the above combination and neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 45.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 45. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 45, and the rejection under 35 U.S.C. §103(a) is not applicable.

It is submitted that the above arguments cures the alleged omission as set forth in the above detailed action.

In view of all of the above, the allowance of the pending claims is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted



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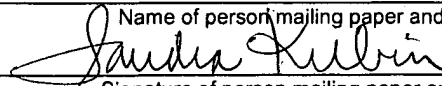
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